

REMARKS

The Amendment filed on October 9, 2003 has not been entered. The rejections in the Final Office Action dated April 16, 2003 remain outstanding.

Claim 6 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. The rejection under 35 U.S.C. § 112, second paragraph is traversed. By the instant preliminary Amendment, Applicants have amended claim 6 to be consistent with claim 1, in accordance with the Examiner's helpful suggestion. Accordingly, withdrawal of the rejection under 35 U.S.C. § 112, second paragraph, of claim 6, is requested.

Claims 1-7 are rejected under 35 U.S.C. § 103 as being unpatentable over U.S. Patent No. 5,292,688 to Hsiao et al. ("Hsiao") in view of U.S. Patent No. 5,828,126 to Thomas, or U.S. Patent No. 5,468,999 Lin et al. ("Lin"), or U.S. Patent No. 6,324,067 to Nishiyama. Applicants have canceled claim 7 without prejudice or disclaimer, rendering the rejection of claim 7 moot. The rejections under 35 U.S.C. § 103, of claims 1-6, are respectfully traversed. By the instant preliminary Amendment, Applicants have amended claim 1. Claim 1 recites a wiring board including an electronic component embedded in an embedding resin having a dielectric constant of less than or equal to about 5 and $\tan\delta$ of less than or equal to about 0.08. A substrate in which a build-up layer formed by laminating an insulating and a wiring layer in alternate fashion is formed above said embedding resin. Support for these features is provided at, for example, Figs. 1-9 and paragraphs 0086 – 0091, of Applicants' specification as originally filed. The Office Action dated April 16, 2003 relies on Thomas, Lin and Nishiyama for a teaching of a substrate in which a build-up layer is formed by laminating insulating and wiring layers in alternate fashion. However, it is submitted that neither Hsiao, Thomas, Lin, nor Nishiyama, considered alone or in combination, teach or suggest a substrate in which a build-up layer formed

by laminating an insulating and a wiring layer in alternate fashion is formed above the embedding resin, as recited in claim 1.

Claims 1-7 stand rejected under 35 U.S.C. § 103 as being unpatentable over U.S. Patent No. 5,589,714 to Howard in view of Thomas, or Lin et al., or Nishiyama. Applicants have canceled claim 7 without prejudice or disclaimer, rendering the rejection of claim 7 moot. The rejections under 35 U.S.C. § 103, of claims 1-6, are respectfully traversed. Applicants have amended claim 1 as described above. It is submitted that neither Howard, Thomas, Lin, nor Nishiyama, considered alone or in combination, teach or suggest a substrate in which a build-up layer formed by laminating insulating and wiring layers in alternate fashion is formed above the embedding resin, as recited in claim 1.

Claims 2-6 ultimately depend from claim 1, and recite the same combination of allowable features recited in claim 1, as well as additional features that further distinguish over the applied art. For at least the above described reasons, Applicants request that the rejections under 35 U.S.C. § 103, of claims 1-6, be withdrawn.

Claims 1-7 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-9 of U.S. Patent Application No. 10/026,928 (now U.S. Patent No. 6,586,827). Applicants have canceled claim 7 without prejudice or disclaimer, rendering the rejection of claim 7 moot. The obviousness-type double patenting rejection of claims 1-6 is respectfully traversed. The Office Action asserts that claims 1-6, while not identical to claims 1-9 of Application No. 10/026,928, are structurally and materially the same as claims 1-9 of Application No. 10/026,928. Applicants respectfully submit that claims 1-6 of the instant application are not structurally and materially the same as claims 1-9 of Application No. 10/026,928, and are patentably distinct from claims 1-9 of Application No.

10/026,928. For example, claims 1-6 of the instant application recite "an embedding resin having a dielectric constant of less than or equal to about 5 and $\tan\delta$ of less than or equal to about 0.08." For the obviousness-type double patenting rejection to be proper, there must be a suggestion or teaching in the prior art that would motivate one of ordinary skill in the art to modify the invention recited in the Application No. 10/026,928 claims to reach the invention recited in the instant claims. Applicants respectfully submit that there is no suggestion or motivation provided in the Office Action to modify the features of the Application No. 10/026,928 claims such that the invention recited by the Application No. 10/026,928 claims is an obvious variant of the invention recited by the instant claims. Accordingly, Applicants respectfully request that the rejection of claims 1-6 under the judicially created doctrine of obviousness-type double patenting be withdrawn. Applicants respectfully submit that all pending claims are in condition for allowance.

If there are any fees due in connection with the filing of this response, please charge the fees to our Deposit Account No. 50-0310. If a fee is required for an extension of time under 37 C.F.R. 1.136 not accounted for above, such an extension is requested and the fee should also be charged to our Deposit Account.

Respectfully submitted,

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Dated: December 15, 2003

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